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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,028	02/18/2004	Yoshiharu Baba	TS8069 (US)	2833

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Yukiko Iwata
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Legal - Intellectual Property
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EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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11/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/781,028

Applicant(s)

BABA ET AL.

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, and its dependent claims, have been amended to recite a method comprising replacing in a system a hydraulic fluid with one set of properties with a hydraulic fluid having a second set of properties. It is not clear from either the claims or the specification whether "replacing" refers to actually removing a hydraulic fluid having the first set of properties from a system and adding the fluid having the second set of properties, or whether "replacing" is meant in a conceptual sense, that the hydraulic fluid having the second set of properties is added to the system instead of the fluid having the first set of properties. In the case where "replacing" means actually removing the first hydraulic fluid, the rejection set forth under 35 USC 112, first paragraph in paragraph 4 below applies. In the case where "replacing" is meant in a conceptual sense, the rejections set forth under 35 USC 102 and 103 below apply, and any new grounds of rejection have been necessitated by the amendment.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant argues that paragraphs 9 and 134 of the specification provide support for the amendment, but paragraph 9 simply contains a general statement that the present invention has desirable properties, and paragraph 134 notes that density makes a contribution to energy efficiency, but does not give any suggestion of the method of claim 1, not does it mention a hydraulic fluid having the first set of properties in amended claim 1. Applicant also points to Table 7 as providing support, but none of the comparative examples possess the first set of properties in claim 1—comparative examples and 18 have viscosity indices outside the claimed range, and according to Table 6, comparative examples 16-18 all have kinematic viscosities outside the claimed range. In fact, none of the comparative examples listed in Tables 3-5 possess the first set of properties—comparative examples 1-5 and 14-15 have densities outside the claimed range, and comparative examples 6-13 have viscosity indices outside the claimed range.

The application as originally filed therefore does not provide support for a method comprising removing a hydraulic fluid having the first set of properties from a system

and adding the fluid having the second set of properties, and does not even provide support for a hydraulic fluid having the first set of properties recited in amended claim 1.

Claim Rejections - 35 USC § 103

5. Claims 1, 7, 13, 15, 19, 21-22, 24-26, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garwood in view of Ishida.

Garwood, in column 15 lines 1-25 (Table 2), discloses the properties of a lubricant basestock, which Garwood teaches in column 5 lines 24-28 may be derived from a Fischer-Tropsch product, as recited in Claim 7. The lubricant basestocks "1-1" and "3-1" have viscosity indices, kinematic viscosities, and densities falling within the ranges recited in Claims 1, 7, 13, 15, 19, 21-22, and 24-26 (density = $(141.5 / (131.5 + \text{API Gravity}))$). In column 14 lines 1-7, Garwood further teaches that the additives such as antioxidants and extreme pressure agents, as recited in Claims 28 and 30, may be added to the lubricant basestocks to form lubricating compositions. Garwood does not describe a method of using the basestock in a hydraulic system.

Ishida, in from column 1 line 65 through column 2 line 3, discloses a lubricating oil composition comprising an oil with a kinematic viscosity of 10 to 10,000 cST at 40° C and a viscosity index of not less than 80, a metal deactivator additive, and other lubricant additives described in column 3 lines 50-55, including some of those disclosed by Garwood. The lubricating composition of Garwood fits the requirements for the base oil in the composition taught by Ishida. In column 3 lines 62-68, Ishida teaches that the lubricating composition may be used in a hydraulic oil. The use of this hydraulic oil in a

hydraulic system meets the limitations of claims 1, 7, 13, 15, 19, 21-22, 24-26, 28, and 30.

It would have been obvious to one of ordinary skill in the art to use the lubricant of Garwood in a hydraulic system as Ishida teaches that the lubricant is a suitable base for a hydraulic fluid.

6. Claims 2-3, 8-9, 14, 23, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garwood in view of Ishida as applied to claims 1, 7, 13, 15, 19, 21-22, 24-26, 28, and 30 above, and further in view of Richardson.

The discussion of Garwood in view of Ishida paragraph 5 above is incorporated here by reference. Garwood and Ishida do not disclose a tertiary alkyl-primary amine additive.

Richardson, in column 10 lines 1-14, describes a tertiary alkyl-primary amine additive for a mineral oil-based lubricant composition. Richardson teaches in column 10 line 5 that the additive preferably contains 8 to 22 carbon atoms, strongly overlapping the range recited in Claim 2. In column 10 lines 12-15, Richardson teaches several amines (tert-octylamine, tert-decylamine, tert-dodecylamine, etc.) where the number of carbon atoms falls within the range recited in Claim 2. The use of the additive taught by Richardson in the composition of Garwood also satisfies Claims 8-9, 14, 23, and 29. In column 2 line 27, Richardson teaches that the amine additive (component A) is preferably used in an amount of 0.5 to 5% by weight of the lubricant composition, falling within the range recited in Claim 3.

It would have been obvious to one of ordinary skill in the art to include in the lubricant composition of Garwood a tertiary alkyl-primary amine, as taught by Richardson, due to its use as an anticorrosion agent and friction modifier.

7. Claims 1, 4, 13, 16, 22, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida in view of Chevron USBO 7R.

The discussion of Ishida in paragraph 5 above is incorporated here by reference. Ishida discloses a lubricating oil composition comprising an oil with a kinematic viscosity of 10 to 10,000 cSt at 40° C and a viscosity index of not less than 80, which can be used in a hydraulic oil, but does not disclose a specific lubricant basestock.

As discussed in paragraph 2 of the office action mailed 10/2/06, Chevron UCBO 7R is a base oil with a kinematic viscosity of 39 cSt at 40° C and a viscosity index of 135, meeting the requirements of the base oil of Ishida, and a density of 0.834 g/cm³ and a flash point of 239-240° C, falling within the ranges recited in claims 1, 4, 13, 16, 22, and 25.

It would have been obvious to one of ordinary skill in the art to use Chevron UCBO 7R as the lubrications basestock for the hydraulic oil of Ishida, as it meets the viscosity and viscosity index requirements.

8. Claims 5-6, 17-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida in view of Chevron UCBO 7R as applied to claims 1, 4, 13, 16, 22, 25, and 27 above, and further in view of Richardson.

The discussions of Ishida in view of Chevron UCBO 7R in paragraph 7 above and Richardson in paragraph 6 above are incorporated here by reference. The use of the tertiary alkyl-primary amine additive of Richardson in the base oil of Ishida and Chevron UCBO 7R meets the conditions of Claims 5, 6, 17-18, and 20.

It would have been obvious to one of ordinary skill in the art to include in the lubricant composition of Ishida and Chevron UCBO 7R a tertiary alkyl-primary amine, as taught by Richardson, due to its use as an anticorrosion agent and friction modifier.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida in view of Chevron UCBO 7R as applied to claims 1, 4, 13, 16, 22, 25, and 27 above, and further in view of O'Rear.

The discussion of Ishida in view of Chevron UCBO 7R in paragraph 7 above is incorporated here by reference. Ishida in view of Chevron discloses the use of a Group III base oil meeting the limitations of Claim 4 in a hydraulic system, but Chevron does not disclose a Fischer-Tropsch process.

In column 7 lines 34-36, O'Rear teaches that Fischer-Tropsch wax, as in Claim 10, is an "ideal feed" for the production of Group III base oils. It would have been obvious to one of ordinary skill in the art to produce the Chevron base oil from a Fischer-Tropsch product due to the above teaching of O'Rear.

10. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida in view of Chevron UCBO 7R and Richardson as applied to claims 5-6, 17-18, and 20 above, and further in view of O'Rear.

The discussions of Ishida, Chevron UCBO 7R, Richardson, and O'Rear in paragraphs 7-9 above are incorporated here by reference. Ishida in view of Chevron and Richardson discloses the use of a Group III base oil meeting the limitations of Claim 5-6 in a hydraulic system, but Chevron does not disclose a Fischer-Tropsch process.

In column 7 lines 34-36, O'Rear teaches that Fischer-Tropsch wax, as in Claim 10, is an "ideal feed" for the production of Group III base oils. It would have been obvious to one of ordinary skill in the art to produce the Chevron base oil from a Fischer-Tropsch product due to the above teaching of O'Rear.

Response to Arguments

11. The new grounds of rejection reflect the use of the lubricating compositions in a hydraulic system. While applicant argues that it has discovered that density of the lubricant has an effect on the efficiency of a hydraulic system, it is noted that "The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the prior art teaches compositions with the same properties as the claimed compositions, and suggests its use as a hydraulic fluid. See paragraphs 2 and 4 for further comments on applicant's amendment.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 9-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/781,028
Art Unit: 1797

Page 10

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